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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,432	02/17/2000	John R. Stevens	032795-001	6452

28581 7590 07/03/2003

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EXAMINER

NGUYEN, DINH X

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/506,432

Applicant(s)

STEVENS ET AL.

Examiner

Dinh X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 16-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of group I, claims 1-15 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that (1) the invention is made up of discrete or sub-system, (2) the examiner did not state the rationale in making the species restriction requirement, and (3) the species are related by the fact that they make up a business system that provides an end-to-end Internet connectivity solution for the worker's compensation industry which eliminates phone, fax and mail transactions involved in the medical treatment, reporting, claims for payment, and payment for the services rendered. This is not found persuasive because:

With respect to argument (1): If the invention is made up of discrete or sub-system, then this indicates the fact that they are the components are divergent in nature and should be examined separately due to their divergent nature, either based on an invention or a species restriction requirement. The fact that the claims are so divergent in nature, making it a heavy burden on the examiner's searching requirements further warrant a restriction requirement.

With respect to argument (2): A species restriction requirement does not require a detailed rationale. However, Applicant has requested the rationale regarding the differences between each species. Examiner notes that the listing of the species grouping indicates the differences, such as certain claims drawn to a filtering software, while certain claims are drawn toward a renaming software.

With respect to argument (3): The fact that the "invention" as a whole and therefore all claims relate to a business system which provides an end-to-end internet connectivity solution eliminating phone, fax and mail transactions, are so broad in nature that anything that utilizes the internet would be considered tied in with Applicant's invention. Applicant has argued that the claims are significant in that they all tie in with medical treatment or worker's compensation, etc., is not persuasive, since some independent claims and groupings do not mention anything about worker's compensation and medical treatment (such as claims 22 and 42-44).

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman, USPN 5,544,044.

Leatherman discloses a system comprising software prompting claim data input, utilizing a network of computers as claimed except explicitly disclosing worker's compensation claims. See abstract, figure 2a items 3, 4, 5, 11, 12, 19+ and col. 3 lines 1-5 for example. However, it is well known in the art as indicated in Applicant's arguments in the previous response and in the specification, that medical claims include

worker's compensation claims. Leatherman teaches that the system is for any type of claims, and therefore one of ordinary skill in the art would have been motivated to include worker's compensation claims in order to carry out the reporting and updating of all types of medical claims.

With respect to claim 2, Applicant has not defined just exactly what is considered an early alert message, therefore it reads on any message that Leatherman discloses in the inputting software system.

With respect to claims 3-15, see above citation. Note that Leatherman's system explicitly discloses that information is updated, merged, obtained from the customer, and extracted, thus meeting all of the steps as claimed. Any specific information that is relevant, such a claim number, social security number and type of injuries would have been inputted or exchanged, if not explicitly disclosed by Leatherman, then one of ordinary skill in the art would have done so since these data are highly relevant in medical claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh X. Nguyen whose telephone number is (703) 305-3522. The examiner can normally be reached on Monday to Thursday and alternate Fridays..

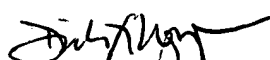
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

DXN  
June 29, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER